

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURITS BOYE RAMUSSEN

Appeal No. 2002-2062
Application No. 09/207,631

ON BRIEF

Before OWENS, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15-23, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a method of manufacturing a molded breast prosthesis. An understanding of the invention can be derived from a reading of claim 15, the sole independent claim on appeal, which is reproduced below.

15. A method of manufacturing a moulded, foil-wrapped breast prosthesis comprising joining two foil sheets of a formable plastic material to provide a prosthesis bag, said foil sheets forming a front side and a rear side, respectively, of said bag and said bag having a filling opening;

filling said bag with a quantity of a curable compound and thereafter sealing the filling opening of the bag;

placing the filled bag into a mould cavity of a mould, said mould cavity having an opening and a bottom wall with a surface corresponding to a desired shape of said front side of the prosthesis, said front side being placed in contact with said bottom wall surface;

applying vacuum to said bottom wall of the mould cavity to bring the bag into close contact therewith;

whereafter the compound is cured and the moulded prosthesis is removed from the mould, characterized in that the curing is performed without closing the mould cavity at said opening and the vacuum is maintained until at least the compound closest to said front side of the bag placed in close contact with said bottom wall surface is cured.

Tourniaire
(France)¹

2 564 728

May 24, 1984

Claims 15-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tourniaire in view of Degler and Brogan.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Upon careful review of the entire record including the respective positions advanced by appellants and the examiner, we find ourselves in agreement with appellants in so far as the examiner has failed to carry the burden of establishing a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984). Accordingly, we will not sustain the examiner's rejection. Our reasoning follows.

The primary reference, Tourniaire (FR 2,564,728), is relied upon by the examiner for disclosing a method for making a breast prosthesis from silicone elastomer employing a mold. The mold of Tourniaire includes a bottom wall containing mold cavity for containing the liquid elastomer with an opening therein left open to allow for dilation during heating or curing that shapes and hardens the elastomer according to the examiner. The examiner also notes that Tourniaire discloses the option of placing the prosthesis in an envelope after molding thereof. See pages 4 and 5 of the answer.

The examiner acknowledges that Tourniaire does not disclose molding silicone (curable compound) in a bag or applying vacuum to a bottom wall of the mold cavity. See pages 3 and 5 of the answer. In fact, the examiner has not shown nor do we find where Tourniaire discloses any of appellant's claimed steps of: (1) joining foil sheets to form a prosthesis bag having a filling opening; (2) filling the bag with a curable compound and subsequently sealing the bag filling opening; (3) placing the

curable compound within and closest to the front side of the bag and the bottom wall surface of the mold is cured.

The examiner relies on Degler and Brogan in an attempt to make up for the extensive deficiencies in the teachings of Tourniaire. Rather than repeating the examiner's explanation here or giving a shortened version thereof, we refer to pages 3-9 of the answer.

Degler discloses making a breast prosthesis using a mold wherein a stretched first film is placed on a female mold and heated and conformed to the mold shape, the first film is removed from the mold, a specially shaped insert is inserted in the female mold, the previously contoured first film is placed over the insert, the female mold is filled with resin up to an edge thereof, a second film is employed to cover the resin, the first and second films are welded together along overlapping edges, the insert is removed, a male mold is used to permanently shape the second film, the resin is cured. A vacuum is disclosed as being applied during various steps including the curing step with the

the bag with resin, sealing the bag, placing the filled bag in a mold, and molding the resin while in the bag and while applying a vacuum. As acknowledged by the examiner (answer, page 6), however, Brogan, like Degler, employs a closed mold cavity during the vacuum applied molding step to form the desired molded product rather than leaving the mold cavity open at an opening thereof as required by appellant's claimed method.

The difficulty we have with the examiner's obviousness position is that the examiner has not fairly explained why the disparate teachings of Brogan and Degler would have led one of ordinary skill in the art to modify the method of Tourniaire in a manner so as to arrive at the claimed subject matter. "It is well established that before a conclusion of obviousness may be made based on a combination of references, there must have been a reason, suggestion or motivation to lead an inventor to combine those references." Pro-Mold and Tool Co. v. Great Lakes Plastics Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629 (Fed. Cir. 1996).

The examiner has only made general statements and

molding suggested by Degler (answer, page 5). Those statements by the examiner regarding the teachings of Degler leave out other teachings of Degler concerning how such a filled bag should be molded to form a prosthetic device. On this record, the examiner has not made clear from the overall teachings of the applied references teachings why one of ordinary skill in the art would have been led by the particular and disparate disclosures of Degler and Brogan to modify the significantly different method of Tourniaire so as to arrive at the herein claimed subject matter. In this context, the examiner's rejection falls short in speculating about motivation rather than identifying a persuasive and particularized suggestion, reason or motivation founded in the applied references, in the nature of the problem to be solved and/or in evidence establishing the skill in the art, a suggestion that is sufficiently compelling to predicate a combination of the references thereon in a manner so as to arrive at the claimed invention. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

In the present case, sufficient evidence to establish such a suggestion is not made manifest in the examiner's stated rejection based on the teachings of the applied references for reasons as stated above and in appellant's briefs. We conclude that the examiner has failed to establish a prima facie case of obviousness with respect to the subject matter of the appealed claims.



CONCLUSION

The decision of the examiner to reject claims 15-23 under 35 U.S.C. § 103 as being unpatentable over Tourniaire in view of Degler and Brogan is reversed.

REVERSED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CATHERINE TIMM)	
Administrative Patent Judge)	

PFK/sld

Appeal No. 2002-2062
Application No. 09/207,631

Page 10

OSTROLENK FABER BERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403